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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/271,964	03/18/1999	KARL FRANCIS HORLANDER	RCA89127	5009

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EXAMINER

SRIVASTAVA, VIVEK

ART UNIT PAPER NUMBER

2611

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/271,964

Applicant(s)

HORLANDER ET AL.

Examiner

Vivek Srivastava

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27 is/are allowed.
- 6) ☒ Claim(s) 20-22 and 26 is/are rejected.
- 7) ☒ Claim(s) 23-25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1, 2, and 3</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipated by Stefik et al (5,629,980).

Regarding claim 20, Stefik discloses video processing system which controls the use of digital works (see video – col 6 lines 37 – 40) by enforcing usage rights for copying or ‘copyright’ (see col 6 lines 50 – 56 and col 34 lines 36 – 67). Stefik further discloses a repository receives and stores usage rights or copyright information from a creator or ‘first source’ (see col 7 lines 8 – 22). Stefik further discloses that the number of copies of digital works can be requested and subsequently the copy-count field for the copy of the digital work being sent is set to the number-of-copies requested (see col 34 lines 54 – 61). It is noted that the number of copies count field receives the correct number of copies possible from the second source (inherently in the server repository) and updates the copy-count field or copyright information.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21, 26 rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al.

Regarding claim 21, Stefik fails to disclose wherein said first copyright information is received by selecting an available program from a list of available programs provided by an electronic program guide, each of said available programs having associated initial copyright information.

The Examiner takes Official Notice an electronic program guide would have been a well known means for providing a easy user friendly means for facilitating the selection of video signals. For example, in the interactive video distribution art, it would have been well known to utilize an EPG to facilitate the selection of video programming like television channels, video on demand movies, PPV movies etc. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Stefik to include the claimed limitation to provide an easy more friendly means for facilitating the selection of digital works.

Regarding claims 22 and 26, Stefik discloses storing initial copyright information for digital works in a server repository (see col 34 lines 37 - 68). When a user on a requester platform requests and thus selects one of the available digital works, the user on the requestor platform receives the digital works program with updated usage copy-count information (see col 31 line 52 – col 32 line 18). It is noted that since the server repository can only provide for a number of copies, the initial copy count in the server updated each time a request for a copy is sent out. For example, if the server has an initial copy-count of 2 and a user on a requester platform requests 1 copy, the initial copy count is updated to 1 and the requester is provided with the copy-count requested i.e. 1.

Although Stefik discloses a user interface with icons (see col 16 lines 42 – 65) enabling selection of digital works (noting that the icons have associated copyright information), Stefik fails to disclose electronic program guide. The Examiner takes Official Notice an electronic program guide would have been a well known means for providing a easy user friendly means for facilitating the selection of video signals. For example, in the interactive video distribution art, it would have been well known to utilize an EPG to facilitate the selection of video programming like television channels, video on demand movies, PPV movies etc. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Stefik to include the claimed limitation to provide an easy more friendly means for facilitating the selection of digital works.

Allowable Subject Matter

Claims 23 – 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 27 is allowed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kanota et al (5,991,500) – Copy control for a video signal

Inoue et al (6,438,319) – Recording digital video signals

Vincett et al (5,299,026) – Tracking the reproduction of documents


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivek Srivastava whose telephone number is (703) 305-4038. The examiner can normally be reached on Monday – Friday from 9 am to 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (703) 305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vs

1/27/05



VIVEK SRIVASTAVA
PRIMARY EXAMINER